

**Remarks**

The Applicants note with appreciation the allowance of Claims 1 and 2.

The Applicants have amended the Specification at page 14 in accordance with the Examiner's helpful suggestion to provide the appropriate antecedent basis. Withdrawal of the objection to the Specification is respectfully requested.

The Applicants have amended Claims 15 and 16 to add "C" in accordance with the Examiner's helpful suggestion to place those claims into proper form. Withdrawal of the §112 rejection is respectfully requested.

The Applicants acknowledge the continued rejection of Claims 5 – 6 and 15 - 16 over the hypothetical combination of JP '966 with JP '441.

The Applicants respectfully submit that those claims, namely Claims 5 – 6 and 15 – 16, are patentable over JP '441 and JP '966, whether taken individually or collectively.

First, as a matter of clarification, the Applicants have not taken the position that JP '441 and JP '966 are not analogous art. They are analogous disclosures in the same field of art. In fact, the Applicants discussed JP '441 in detail in the Specification. The Applicants have, however, taken the position that it would not be appropriate to make the hypothetical combination of JP '966 with JP '441. The Applicants also now additionally take the position that, even if one of ordinary skill in the art were to make the hypothetical combination, the resulting combination would still fail to teach or suggest the invention as recited in Claims 5 – 6 and 15 – 16.

The Applicants note with appreciation the Examiner's helpful and detailed comments in support of the Official Action. In that regard, we agree with the Examiner's statements that the Applicants' originally filed Specification teaches the criticality of the distance between the inner edge of the baffle plate and edge of the metal strip and the relationship of L and C as it applies to the

inner edge of the baffle plate and edge of the metal strip. In other words, the Applicants' originally filed Specification teaches the criticality of distance C and the relationship of L and C.

Additionally, the Applicants' originally filed Specification teaches the criticality of the distance between the edge jet nozzle and edge of the metal strip and the relationship of L and C as it applies to the edge gas jet port and edge of the metal strip. This is inherently so by virtue of the fact that the relationship of L and C is taught to be important. As a consequence, the distance between the edge jet nozzle and edge of the metal strip, which is the distance L, must inherently be important.

In any event, the Applicants respectfully submit that both disclosures utterly fail to teach or suggest distance L. Careful scrutiny of both disclosures reveals that there is not one word concerning distance L in the text and there is nothing in the drawings of either reference that indicates the existence of distance L, much less its importance by itself and/or in conjunction with distance C.

In that regard, the Applicants note the Examiner's helpful comments that

"Japan '966 teaches a control means for controlling position of the gas edge nozzle relative to edge of the strip in a hot dipping apparatus and obvious the control means for the drive means is capable of optimizing the position of the gas edge nozzle such that the clearance C and the relationship between distance L and clearance C is maintained within the scope of claims 5 – 6 and 15 – 16 to prevent problems associated with hot dipping..."

In other words, this is a statement that the controller of JP '966 is capable of optimizing the position of the gas edge nozzle such that clearance C and the relationship of distance L and clearance C are maintained according to the claimed formula.

There are two problems with this approach. First, it is mere speculation that the control means for the drive means of JP '966 is capable of optimizing the position of the gas edge nozzle to meet the relationship in distance L and clearance C. Careful scrutiny of the entire JP '966

disclosure reveals that there is nothing in that disclosure that indicates that the control means is capable in the way described. This is simply speculation in the Official Action that such a controller has that ability. As a consequence, the utilization of JP ‘966 as a reference, either alone or in combination with JP ‘441, cannot be supported.

Of even greater importance is the fact that JP ‘966 does not recognize distance L at all. As a consequence, one of ordinary skill in the art would have no reason to make the speculated upon optimization as set forth in the Official Action. In other words, how could one of ordinary skill in the art optimize something that they don’t even recognize? Moreover, how could one of ordinary skill in the art make the optimization when they do not recognize the need for optimization or the very existence of distance L, whether taken by itself or in conjunction with distance C or any criticality of the relationship between distance L and distance C?

The answer to both of those questions is that the absolute failure by JP ‘966 to recognize distance L, irrespective of its importance taken alone, inherently means that one of ordinary skill in the art would not attempt to make any optimization because they would have absolutely no appreciation for the importance of the relationship between distance L and distance C.

As a consequence, the hypothetical combination of JP ‘966 with JP ‘441 must fail. It should be remembered that the test of obviousness requires teachings or suggestions in the prior art to make a modification and a reasonable expectation of success by one of ordinary skill in the art. The hypothetical combination of JP ‘966 with JP ‘441 fails both prongs of this critical test. Specifically, there are no teachings in JP ‘966 at all concerning distance L. Therefore, there are no teachings or suggestions to modify JP ‘441 by introducing a non-existent distance L and/or a non-existent relationship between distance L and distance C. JP ‘966 is utterly non-enabling with respect to

providing teachings or suggestions to make modifications concerning distance L, whether taken alone or in relationship with distance C.

As a consequence of the utter failure of JP '966 to teach or suggest utilizing a distance L, either alone or in combination with distance C as mentioned above, JP '966 inherently fails to provide one of ordinary skill in the art with a reasonable expectation of success. How can one of ordinary skill in the art have a reasonable expectation of success with respect to a particular modification when the modification has not been taught or suggested in the first place? The answer is that it cannot.

The Applicants respectfully submit that neither of JP '441 and JP '966 provide teachings or suggestions to one of ordinary skill in the art, whether taken individually or collectively, that would result in the invention as recited in Claims 5 – 6 and 15 – 16. The Applicants accordingly respectfully request withdrawal of the 35 U.S.C. §103 rejection.

In light of the foregoing, the Applicants respectfully submit that the entire Application is now in condition for allowance, which is respectfully requested.

Respectfully submitted,



T. Daniel Christenbury  
Reg. No. 31,750

TDC:lh  
(215) 656-3381